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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Patrick Schiffrine

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7590

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EXAMINER

FISHER, ELANA BETH

ART UNIT

PAPER NUMBER

3733

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,547	Applicant(s) SCHIFRINE ET AL.	
	Examiner ELANA B. FISHER	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10 and 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/09/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 9, 2009 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10 and 12-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendments to claim 10 and the language in newly added claim 15, contains subject matter that was not described in the specification. Specifically, the claims refer to a "displacement component". This is said refer to the same structure as the "tensioning component" of claim 1, however there is nothing in the specification or the previously presented claim language that allows one skilled in the art to understand that these are referring to the same device.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3733

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 recites the limitation "the ancillary component" in twelfth line of the claim.

There is insufficient antecedent basis for this limitation in the claim.

6. Claim 3 recites the limitation "the dimension of the tensioning component plate" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 4 recites the limitation "the axis of the knee" in the fifth and sixth lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 7 recites the limitation "the anterior surface" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 10 recites the limitation "the base mounting element" in nineteenth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 12 and 16 recite the limitation "the tibial axis" in the last two lines of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 10 and 12-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Wixon et al. (U.S. Patent 5,624,444).

Wixon et al. disclose a device for positioning a total knee prosthesis, comprising:
an ancillary component (FIG 2) comprising a centro-medullary rod (26) and a rod base

Art Unit: 3733

(21) located at a proximal end thereof, the centro-medullary rod (26) extending from a first surface of the rod base (21; FIG 2), the rod base comprising base mounting element/attachment part (20), the centro-medullary rod configured to be introduced into a femoral medullary canal; and a displacement component (22; FIG 3), the displacement component (22) comprising a tibial plate (39) configured to be supported on a surface of a tibial cut extending completely across the tibia with a lowermost surface of the displacement component bearing against the tibial cut and the displacement component being completely above the tibia cutting surface, a displacement element (38), the displacement element operable to displace the tibial plate and the rod base (21) with respect to each other, and a displacement component mounting element/connecting element (34) located on the displacement element and removably engaging with the attachment part (20; FIG 3) to mount the rod base to the displacement element with the rod base being approximately 90 degrees to the tibial plate (FIG 3), wherein the displacement element (38) is movably attached to the connecting element (34) and attached at one end to the tibial plate (39), the displacement element operative to displace the connecting element and the tibial plate with respect to each other between a first position, where the centro-medullary rod and tibial plate are separated by a first distance, and a second position, where the centro-medullary rod and tibial plate are separated by a second distance that is greater than the first distance (FIG 2; FIG 3).

Furthermore, the rod base (21) is a plate with a second surface opposite the first surface, the second surface being generally planar, the base mounting element/attachment part (20) is an oblong passage with a central hole and diametrically opposed notches, the

Art Unit: 3733

displacement component mounting element (34) is a bayonet element for engagement with the oblong passage (FIG 3), the tibial plate (39) is generally planar with a lowermost planar surface configured to be supported on the tibial cut with a lowermost surface of the displacement component bearing against the tibial cut, and the displacement element is vertically aligned with the tibial axis. Additionally, the displacement element comprises a slide housing (42) extending from an upper surface of the tibial plate (39), and a slide (upper portion of 38; FIG 3) displaceable on the slide housing, the slide housing (42) and the slide positioned completely over the tibial plate, the bayonet element (34) is attached to the slide (FIG 3), and the rod base (21), when mounted on the slide, is positioned in vertical alignment with the tibial plate (FIG 3).

Allowable Subject Matter

13. Claims 1 and 3-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Response to Arguments

14. Applicant's arguments with respect to claims 1, 3-8, 10, and 12-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELANA B. FISHER whose telephone number is (571)270-3643. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM EST.

Art Unit: 3733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571)272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elana B Fisher/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733